

### REMARKS

Reconsideration of the application is requested in view of the modifications above and the remarks below. Applicants have cancelled Claims 13, 14, and 17. New Claim 18 has been added. Applicants have modified Claim 1.

#### Objections

The Office Action objected to the wording in Claims 1-10. In view of the modifications above, the objections are believed overcome. Reconsideration is requested.

#### 1. Rejection under 35 USC 112, second paragraph

The Office Action rejected Claims 11-17 under 35 USC 112, second paragraph, on the grounds that the claims omitted essential steps. In view of the modifications above, the rejection is believed overcome. Reconsideration is requested.

#### 2. Rejections under 35 USC 102

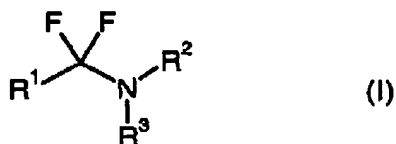
##### A. Rejection of Claims 1-5 and 7-8 under 35 USC 102 over U.S. Pat. No. 3,092,637

The rejection of Claims 1-5 and 7-8 under 35 USC 102 over U.S. Pat. No. 3,092,637 should be withdrawn. It is well settled that in order for a prior art reference to anticipate a claim, the reference must disclose each and every element of the claim with sufficient clarity to prove its existence in prior art. The disclosure requirement under 35 USC 102 presupposes knowledge of one skilled in art of claimed invention, but such presumed knowledge does not grant license to read into prior art reference teachings that are not there. See Motorola Inc. v. Interdigital Technology Corp. 43 USPQ2d 1481 (1997 CAFC).

Applicants' invention relates to a process for preparing compounds of the formula (I)

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where

$\text{R}^1$  represents hydrogen,  $\text{C}_1\text{-C}_{12}\text{-alkyl}$ ,  $[(\text{C}_2\text{-C}_{12}\text{-alkylene})\text{-O}]_n(\text{C}_1\text{-C}_{12}\text{-alkyl})$  where  $n = 1$  to  $5$ ,  $\text{C}_3\text{-C}_{14}\text{-aryl}$ ,  $\text{C}_4\text{-C}_{15}\text{-arylalkyl}$  or  $\text{NR}^4\text{R}^5$ , where  $\text{R}^4$  and  $\text{R}^5$  each independently of one another represent  $\text{C}_1\text{-C}_8\text{-alkyl}$  or  $\text{NR}^4\text{R}^5$  as a whole represents a 4 to 7-membered cyclic radical having a total of 3 to 16 carbon atoms and

$\text{R}^2$  and  $\text{R}^3$  each independently of one another represent  $\text{C}_1\text{-C}_{12}\text{-alkyl}$ ,  $\text{C}_3\text{-C}_{14}\text{-aryl}$  or  $\text{C}_4\text{-C}_{15}\text{-arylalkyl}$ , or together are part of a cyclic radical having a total of 3 to 16 carbon atoms, or

$\text{R}^1$  and  $\text{R}^2$  and/or  $\text{R}^3$  are a cyclic radical having a total of 3 to 16 carbon atoms.

The process involves reacting compounds of the formula (II)



wherein

$\text{R}^1$ ,  $\text{R}^2$  and  $\text{R}^3$  have the meanings given above

in the presence of oxalyl fluoride or a mixture of oxalyl fluoride and difluorophosgene.

U.S. Pat. No. 3,092,637 does not anticipate Applicants' invention. Claim 1 now encompasses a process in which the respective compounds made are made under conditions in which oxalyl fluoride or a mixture of oxalyl fluoride and

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difluorophosgene is present. U.S. Pat. No. 3,092,637 does not disclose a process that produces the compounds indicated above under conditions that require the presence of oxalyl fluoride (alone or mixed with difluorophosgene). Further, U.S. Pat. No. 3,092,637 does not mention the possibility of using oxalyl fluoride instead of or in addition to difluorophosgene. In other words, U.S. Pat. No. 3,092,637 does not disclose each and every element of the rejected claims with sufficient clarity to prove Applicants' invention existed in the prior art. Reconsideration is requested.

**B. Rejection of Claims 1-5 and 7-8 under 35 USC 102 over Journal of the Americal Chemical Society (1962) Vol. 84, No. 22, pp 4275-4285**

The Office Action rejected Claims 1-5 and 7-8 under 35 USC 102 over Journal of the American Chemical Society (1962) Vol. 84, No. 22, pp 4275-4285 ("JA CS (1962)").

This rejection should also be withdrawn. JA CS (1962) does not anticipate Applicants' invention. JA CS (1962) also does not disclose does not disclose a process that produces the compounds indicated above under conditions that require the presence of oxalyl fluoride (alone or mixed with difluorophosgene). Further, JA CS (1962) does not mention the possibility of using oxalyl fluoride instead of or in addition to difluorophosgene. JA CS (1962) does not disclose each and every element of the rejected claims with sufficient clarity to prove Applicants' invention existed in the prior art. Reconsideration is requested.

**C. Rejection of Claims 1-5 and 7-8 under 35 USC 102 over Zeitschrift fuer Anorganische under Allgemeine (1986) 537, p. 63-78 ("Allgemeine (1986)")**

The rejection of Claims 1-5 and 7-8 Allgemeine (1986) should also be withdrawn. Allgemeine (1986) does not disclose a process that produces the compounds indicated above under conditions that require the presence of oxalyl fluoride (alone or mixed with difluorophosgene). Further, Allgemeine (1986) does not mention the possibility of using oxalyl fluoride instead of or in addition to difluorophosgene. Allgemeine (1986) does not disclose each and every element of

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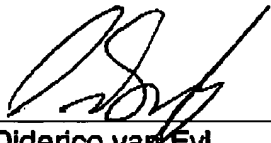
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the rejected claims with sufficient clarity to prove Applicants' invention existed in the prior art. Reconsideration is requested.

In view of the remarks and amendments made above, Applicants earnestly request the allowance of all claims.

Respectfully submitted,

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